

THIS OPINION WAS NOT WRITTEN FOR PUBLICATION

The opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.

Paper No. 9

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

MAILED

Ex parte HOWARD VIPPERMAN

JAN 11 1996

Appeal No. 94-0989
Application 07/733,879¹

PAT. & T.M. OFFICE
BOARD OF PATENT APPEALS
AND INTERFERENCES

ON BRIEF

Before JOHN D. SMITH, GARRIS and OWENS, *Administrative Patent Judges*.

OWENS, *Administrative Patent Judge*.

DECISION ON APPEAL

This appeal is from the primary examiner's rejection of claims 1-20, all of the claims pending in the application.

Claim 14 is illustrative and reads as follows:

¹ Application for patent filed July 22, 1991.

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14. A method of manufacturing rubber wheels used on a portable vehicle adhesive remover for removing pinstripes, decals, side moldings and other items adhering to a vehicle, comprising:

a. masticating approximately 100 parts of rubber in a mixer to produce a hot viscous rubber mixture;

b. synthesizing a warm rubber compound by mixing into said rubber mixture, for making a final rubber product which has a hardness of approximately between 40 to 45:

(i) an appropriate amount of oil;

(ii) at least 2 parts of activating agent;

(iii) at least 50 part but not more than 150 parts of inorganic filler; and

(iv) at least 0.5% but not more than 1.5% by parts of cross-linking agent; and

c. vulcanizing said rubber compound in a heated pressure mold to produce said final rubber product as a rubber wheel used on a portable vehicle adhesive remover for removing pinstripes, decals, side moldings and other items adhering to a vehicle.

THE REFERENCES

References Applied by the Examiner

Yankner et al. (Yankner)	4,157,320	Jun. 5, 1979
Schwartz	4,182,702	Jan. 8, 1980

References Cited by the Board

Cooper	3,950,292	Apr. 13, 1976
Coran et al. (Coran)	4,130,535	Dec. 19, 1978

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THE REJECTION

Claims 1-20 stand rejected as being unpatentable under 35 U.S.C. § 103 over Schwartz in view of Yankner.

OPINION

We have carefully considered the specification, first Office action, amendment in response to the first Office action, final rejection, appeal brief, examiner's answer, and references of record. We find, based upon further consideration of the references discussed below, that appellant's claims are vague and indefinite to the extent that determination of obviousness of the claimed subject matter in view of prior art disclosures is not possible. Accordingly, the examiner's rejection of claims 1-20 under 35 U.S.C. § 103 will not be sustained.

Under the provisions of 37 C.F.R. 1.196(b), we enter the following new ground for rejection.

Claims 1-20 are rejected under 35 U.S.C. § 112, second paragraph as being indefinite for failing to particularly point out and distinctly claim the subject matter which appellant regards as the invention.

Each of appellant's independent claims recites a rubber hardness, which hardness appellant's specification (page 2) teaches is critical to the invention. The claims are indefinite

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because the standard on which the hardnesses are based, such as Shore A or Shore D, is not recited in the claims, disclosed in the specification, or determinable from the prior art.²

As is indicated by the discussion of prior art below, rubber hardness can be reported based on more than one standard, and the prior art would not have indicated to one of ordinary skill in the art which standard is used in expressing the hardnesses in appellant's claims.

The references of record which disclose hardnesses report Shore A hardnesses.³ However, Coran (Tables II and VIII) and Cooper (col. 4, lines 7-9 and 68; col. 5, line 56; col. 6, lines 18 and 49; col. 7, line 10), both indicate that rubber hardnesses can be reported as either Shore A or Shore D hardnesses.

Each Shore A hardness disclosed by Coran is about 2 to 5 times higher than the Shore D hardness of the same rubber. The range of Shore D hardnesses (12-61) includes values within appellant's recited range of 40-45. The range of Shore A

² The entire specification as well as the prior art are to be considered when determining the meaning of terms in claims. *In re Marosi*, 710 F.2d 799, 218 USPQ 289 (Fed. Cir. 1983); *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966); *In re Voss*, 557 F.2d 812, 194 USPQ 267 (CCPA 1977).

³ Himes, U.S. Patent No. 4,377,655 (col. 5, lines 33-34); Schwartz, U.S. Patent No. 4,182,702 (Tables I-IV); Yankner et al., U.S. Patent No. 4,157,320 (col. 4, lines 8 and 43); Pilkington et al., U.S. Patent No. 4,504,604 (abstract); Perrone, U.S. Patent No. 4,220,574 (Table III).

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hardnesses (61-98) includes values within the range of Shore A hardnesses (84-91) disclosed by Schwartz (Tables I-IV), the primary reference relied upon by the examiner. Cooper also reports Shore D hardnesses (41 and 42; col. 7, line 10) which fall within appellant's recited range, and Shore A hardnesses (90 and 91; col. 6, line 18) which are much higher and which fall within the range of Shore A hardnesses reported by Schwartz.

Thus, it is not clear whether the hardnesses recited in appellant's claims differ from those disclosed by Schwartz because of differences between the Schwartz rubber compositions and those recited in appellant's claims or because Schwartz reports Shore A hardnesses and appellant recites Shore D hardnesses or hardnesses based on another standard. For this reason, it is not possible to compare appellant's claims with Schwartz or other prior art references to determine whether appellant's claims would have been anticipated under 35 U.S.C. § 102 or obvious to one of ordinary skill in the art under 35 U.S.C. § 103.

In some instances, it is possible to make a reasonable, conditional interpretation of the claims adequate for the purpose of resolving prior art issues to avoid piecemeal appellate review. In the interest of administrative and judicial economy, this course is appropriate wherever reasonably possible. *In re Marosi*, 710 F.2d 799, 218 USPQ 289 (Fed. Cir. 1983); *Ex parte*

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Ionescu, 222 USPQ 537 (Bd. App. 1984); *Ex parte Saceman*, 27 USPQ2d 1472 (BPAI 1993). In other instances, however, it may be impossible to determine whether or not claimed subject matter is anticipated by or would have been obvious over prior art disclosures because the claims are so indefinite that considerable speculation and assumptions would be required regarding the meaning of terms employed in the claims with respect to the scope of the claims. *In re Steele*, 305 F.2d 859, 134 USPQ 292 (CCPA 1962).

In the present case, we consider the claims to be sufficiently indefinite that application of prior art to the claims is not possible. On this basis, we will not sustain the rejection under 35 U.S.C. § 103. It should be understood that this reversal is not a reversal on the merits of the rejection, but rather is a procedural reversal predicated upon the indefiniteness of the claims.

In the event of further prosecution, it is suggested that the examiner consider U.S. Patent No. 5,259,914 to Fisher, which discloses a portable vehicle adhesive remover which includes a rubber wheel having a hardness of 45, and U.S. Patent No. 5,190,620 to Winter, which discloses a portable vehicle adhesive remover having a rubber wheel with a Shore A hardness between 10 and 90, and teaches that hardness can be controlled by use of a plasticizer.

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DECISION

The rejection of claims 1-20 as being unpatentable under 35 U.S.C. § 103 over Schwartz in view of Yankner is reversed. A new ground for rejection has been entered under 37 C.F.R. 1.196(b).


Any request for reconsideration or modification of this decision by the Board of Patent Appeals and Interferences based upon the same record must be filed within one month from the date of the decision (37 C.F.R. § 1.197). Should appellant elect to have further prosecution before the examiner in response to the new rejection under 37 C.F.R. § 1.196(b) by way of amendment or showing of facts, or both, not previously of record, a shortened statutory period for making such response is hereby set to expire two months from the date of this decision.


Failure to request reconsideration or to undertake prosecution before the examiner in a timely manner will result in cancellation of all claims subject to the new rejections.


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No time period for taking any subsequent action in
connection with this appeal may be extended under 37 C.F.R.
§ 1.136(a).

REVERSED 37 C.F.R. 1.196(b)


JOHN D. SMITH)
Administrative Patent Judge)


BRADLEY R. GARRIS)
Administrative Patent Judge)


TERRY J. OWENS)
Administrative Patent Judge)

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Thomas I. Rozsa
Imperial Bank Building, Ste. 1081
15303 Ventura Blvd.
Sherman Oaks, California 91403